

REMARKS

Claims 1 through 10 are currently pending in the application.

Applicant acknowledges with appreciation that the Examiner has indicated that independent claims 9 and 10 remain allowed. Additionally, Applicant acknowledges the indication of allowable subject matter in claims 2, 4, and 8 from a previous Office Action.

Claims 1, 3, and 7 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,734,672 to McMinn (hereinafter “McMinn”).

Independent claim 1 recites, in part, that “...said laser source and said auxiliary electrical component **being mounted on a general plane of extension of a submount...** wherein said...auxiliary electrical component is mounted on said submount so that a **longest dimension of said...auxiliary electrical component is at least substantially orthogonal** to said general plane of said submount.” [emphasis added].

McMinn’s Figures 3A, 3B, and 3C show arrangements of laser array **30** and photodetector **149** mounted on heat sink **148**. However, an earlier diagram and written description of laser array **30** (see Fig. 1B and col. 4, lines 47 – 60) clearly show that the laser sources (laser diode bars **36**) are placed within grooves **34** that are cut *into the top of a (separate) substrate 32*. Substrate **32** is made of an electrically insulative material (col. 4, line 49), and substrate **32** is actually mounted in contact with heat sink **148** in Figures 3A, 3B and 3C by its bottom surface. In essence, McMinn discloses laser sources that are mounted on *two* substrates. Thus, McMinn does not disclose a laser source mounted on the same general plane of extension as the auxiliary electrical component (in McMinn, photodetector **149**).

Moreover, McMinn fails to disclose an auxiliary electrical component that is mounted so that its “longest dimension...is at least substantially orthogonal to said general plane of said submount,” as recited in claim 1. McMinn’s **written** disclosure never purports to describe an

auxiliary electrical component (such as photodetector **149**) that is purposefully positioned to reduce the size of the component's footprint by orienting its longest side "substantially orthogonal" to the plane of the submount. Only the drawings in McMinn's Figures 3A and 3C show photodetectors **149** that are ambiguous whether their overall height is larger than the dimensions of their "footprints" on the heat sink **148** (especially when examining the base and center sections of photodetectors **149**). McMinn's written description is "silent" whether the drawings of the photodetectors **149** in Figures 3A and 3C were to be understood by a person of skill in the art as representing a definite limitation on structure. To underscore this point, McMinn's drawing of photodetector **186** in Figure 4B has a larger footprint than height relative to the substrate, but this is not accorded any meaning in the written description. Had McMinn wished to indicate photodetectors **149** that were taller than their footprint, he could easily have said so, or made the relative dimensions clear in the drawings.

This is similar to a set of facts that occurred in *In re Meng*, 492 F.2d 843 (CCPA 1974), where the prior art references were void of *written content* rendering a pending application obvious, and the only alleged disclosure of the claimed limitation at issue was present in a portion of a utility patent *drawing* in one of the references. The *Meng* court determined that the pertinent question to be answered was: "would one of ordinary skill in the art, presented with that problem and those... prior patents – and totally unaware of appellants' solution – be led to do what appellants' did?" *Meng*, 492 F.2d at p. 846. In that instance, the *Meng* court did not find that the claim at issue was rendered obvious. In so doing, the court upheld the established rule that "references must be evaluated by ascertaining the facts fairly disclosed therein as a whole." *In re Schuman*, 361 F.2d 1008, 1012, 53 CCPA 1251, 1255 (1966). As applied to the present situation, a person skilled in the art, when presented with the McMinn patent – and unaware of the present solution as recited in claim 1 – would not have been led to position the photodetectors so that their heights were greater than the dimensions of their footprints.

Further, for an anticipation rejection to be proper, "the identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applying this principle to the present

matter, McMinn does not show the identical invention in complete detail as recited in claim 1.

Dependent claims 3 and 7 are likewise patentable over McMinn for at least the same reasons as provided for claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under §102(b) to claims 1, 3 and 7 over McMinn.

Dependent claim 5 is rejected under 35 U.S.C. §103(a) as obvious over McMinn.

For at least the same reasons as provided above for independent claim 1, claim 5 is neither disclosed or suggested by McMinn, and thus is patentable over McMinn. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection to claim 5 under §103(a).

Dependent claim 6 is rejected under 35 U.S.C. §103(a) as obvious over McMinn, in view of U.S. Patent No. 5,854,867 to Lee, et al. (hereinafter, "Lee").

Lee is not asserted by the Office Action as disclosing or suggesting a laser source and an auxiliary electrical component mounted on the general plane of a submount as claimed in claim 1, nor of the auxiliary electrical component that is mounted so that its longest dimension is substantially orthogonal to the plane of the submount.

Therefore, for at least the reasons above, McMinn, alone or in combination with Lee, does not disclose or suggest every one of the limitations of claim 6. Accordingly, claim 6 is patentable over McMinn, alone or in combination with Lee.

For these reasons, Applicant respectfully submits that claims 1 through 10 are allowable over the cited art, taken alone or in combination, and earnestly solicits reconsideration and withdrawal of all pending rejections and issuance of a Notice of Allowance.

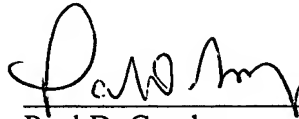
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Paul D. Greeley

Registration No. 31,019

Attorney for Applicant

Ohlandt, Greeley, Ruggiero & Perle, LLP

One Landmark Square, 10th Floor

Stamford, CT 06901-2682

Tel: (203) 327-4500

Fax: (203) 327-6401